No. 78-1477

In the Supreme Court of the United States

OCTOBER TERM, 1978

FORMICA CORPORATION, PETITIONER

v.

SAUL F. LEFKOWITZ, ET AL.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

MEMORANDUM FOR THE RESPONDENTS IN OPPOSITION

WADE H. McCREE, JR.
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Petitioner contends that the United States Court of Customs and Patent Appeals erred by refusing to issue a writ of mandamus to compel the Trademark Trial and Appeal Board of the United States Patent and Trademark Office to dismiss a trademark cancellation proceeding.

1. The Federal Trade Commission petitioned the Trademark Trial and Appeal Board (TTAB) to cancel the federal registration of the trademark "FORMICA," alleging that it had become "the common descriptive name of an article or substance" within the meaning of Section 14(c) of the Lanham Act of 1946, 15 U.S.C. 1064(c). Section 14 authorizes the Commission to apply for cancellation of trademarks registered on the principal register established under the Lanham Act. Petitioner moved to dismiss the cancellation proceeding, contending that the Commission lacks

authority to seek cancellation because, even though the FORMICA trademark has been republished under Section 12(c) of the Lanham Act, 15 U.S.C. 1062(c), it was originally registered under the Trademark Act of 1905.

The TTAB denied the motion to dismiss (200 U.S.P.Q. 182), concluding that trademarks that have been republished under the Lanham Act and have enjoyed its protections are trademarks registered on the Act's principal register. Petitioner filed a petition for mandamus in the United States Court of Customs and Patent Appeals, seeking an order requiring the TTAB to vacate its interlocutory decision denying the dismissal motion. Although recognizing that it possessed "discretionary power to issue writs of mandamus" (Pet. App. A9), the court declined to issue the writ (590 F. 2d 915; Pet. App. A1-A15). The court concluded that issuance of the writ was neither "appropriate" nor "necessary" in light of several considerations (Pet. App. A10). The court first noted that mandamus should not be used as "a substitute for the appeal procedure prescribed by statute" (*id.* at A11), particularly where review is sought of a routine interlocutory order denying a motion that the TTAB is competent to decide (*ibid.*). The court also pointed out that allowance of interlocutory review could seriously protract proceedings before the TTAB and that mandamus should "be restricted to the most serious and critical ills" (*id.* at A12). Finally, after examining petitioner's jurisdictional contentions, the court found that the decision of TTAB had a "rational" and "substantial" basis and could not be deemed a usurpation of jurisdiction (*id.* at A14-A15).[1]

[1]Because the court found no ground to issue a writ of mandamus, it reserved decision on the merits of the jurisdictional claim raised by petitioner (Pet. App. A14-A15).

2. Although petitioner contends that writs of mandamus generally should be available to "lead, supervise and otherwise aid the lower courts" (Pet. 18), the court below properly applied well established limitations in denying the writ. As this Court recently pointed out in *Kerr* v. *United States*, 426 U.S. 394, 402-403 (1976), "[t]he remedy of mandamus is a drastic one, to be invoked only in extraordinary situations." Mandamus is only available in "circumstances amounting to a judicial 'usurpation of power,' " and piecemeal review of interlocutory orders should be discouraged. *Id.* at 402. For these reasons, reviewing courts have broad discretion to deny writs of mandamus and may properly consider both whether ordinary appellate remedies are adequate and whether the petitioner has borne the burden of showing "that [his] right to issuance of the writ is 'clear and indisputable.' " *Id.* at 403. Accord, *Will* v. *Calvert Fire Insurance Co.*, 437 U.S. 655, 661-662 (1978) (plurality opinion); *Will* v. *United States*, 389 U.S. 90, 95-96 (1967); *Roche* v. *Evaporated Milk Association*, 319 U.S. 21, 26-31 (1943). The court properly declined to issue the writ here because petitioner failed to show that the TTAB was clearly and indisputably in error in assuming jurisdiction or that ordinary review of a final decision is an inadequate remedy.[2]

Contrary to petitioner's assertion (Pet. 10-14), the decision here does not conflict with the decision of any court of appeals. Although petitioner cites cases in which different considerations have been articulated by courts of appeals in granting or withholding mandamus relief in various circumstances, that is simply a

[2]The Court of Customs and Patent Appeals has issued writs of mandamus to correct clear usurpations of jurisdiction when ordinary appellate remedies are inadequate. See, *e.g.*, *United States* v. *Boe*, 543 F. 2d 151 (1976), cited in the opinion below (Pet. App. A12).

reflection of the fact that "issuance of the writ is in large part a matter of discretion with the court to which the petition is addressed." *Kerr* v. *United States District Court, supra,* 426 U.S. at 403. None of the cases cited by petitioner suggests that reviewing courts are required to issue writs of mandamus whenever a novel legal question is raised on a motion to dismiss. And there is no reason to believe that any court of appeals would conclude that it was compelled to issue mandamus in a case such as this, where the petitioner calls for review of a question of first impression without demonstrating either that the decision sought to be reviewed is clearly incorrect or that normal remedies are inadequate.

It is therefore respectfully submitted that the petition for a writ of certiorari should be denied.

WADE H. MCCREE, JR.
Solicitor General

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